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132. The method of claim 42 wherein the minimum house advantage of the range is about zero.

REMARKS:

This application has been carefully studied and amended in view of the Office Action dated November 6, 2001. Reconsideration of that action is requested in view of the following remarks which incorporate matters discussed by the undersigned attorney with Examiner Pierce. Examiner Pierce is thanked for the courtesies and suggestions made in these discussions.

With regard to the multiplicity rejection claims 88-129, which were not examined in the Office Action, have been canceled. Such cancellation is made in order to advance the prosecution of this case and without prejudice for presenting those claims in a continuing application.

With regard to the rejection on the ground of double patenting attached hereto is a Terminal Disclaimer with respect to pending application 09/875,753. The filing of this Terminal Disclaimer is made to advance the prosecution of this case so that the double patenting rejection will be moot; and is not intended to reflect on any agreement or disagreement with the basis of the rejection.

Claims 3, 48 and 56 which were among the claims previously examined have been canceled since the subject matter of those claims are now incorporated in their parent claims. Claims 130-132 have been added. The addition of these claims does not result in any increase in the number of claims which were previously examined. Accordingly, the addition of claims 130-132 in

combination with the cancellation of a like number of examined claims should not have any affect on the previous multiplicity rejection.

There are presently pending four independent claims, namely, claims 1, 19, 25 and 42. Claims 2 and 4-18 are dependent on claim 1. Claims 20-24 are dependent on claim 19. Claims 26-30 are dependent on claim 25. Claims 43-47, 49-55, 57-58 and 130-132 are dependent on claim 42.

The present invention as defined in the various claims is directed to a method of playing a casino game which includes an underlying game of chance and a knowledge-based game. The invention, in general, includes a player playing the game of chance which would result in the award of a payoff when a winning combination occurs. As defined in the claims a knowledge-based bonus game is played when a bonus condition occurs in the underlying game. Such bonus condition might result before the player has qualified for an award or payoff. In that instance the knowledge-based game would be played where the payoff for the underlying game is zero. The claims therefore refer to "entitled" payoff of the underlying game to take into account the possibility that there is no award in the underlying game if a winning combination had not yet reached. The play of the knowledge-based game would entitle the player to the possibility of a "second" payoff based upon the outcome of the knowledge-based game. As also defined in each of the independent claims, the payoff from the underlying game of chance is awarded regardless of the outcome of

the knowledge-based game. Thus, the player has the incentive for playing because the player knows that whatever payoff the player might have been entitled to from the underlying game of chance, such payoff will not be jeopardized by playing the knowledge-based game. A player who is motivated to play the casino game in order to play the knowledge based game would have to first play the underlying game of chance. Play of the knowledge-based game results only when a bonus condition occurs in the underlying game. As a result, the casino game is attractive to the players and yet enough safety factors are built into the games that even where the knowledge-based game is sometimes played with a player having perfect knowledge, over time the combined house advantage of the two games would be at an acceptable level. Claim 42, for example, includes the features of the game of chance having a positive house advantage. This house advantage in combination with the frequency with which the knowledge-based game would be played would result in a house advantage having a predetermined range for the combined knowledge-based game and game of chance wherein the range has a minimum house advantage which is based upon all answers to all queries in the knowledge-based game being correct. A substantial portion of the range is a positive house advantage. Newly added dependent claim 130 defines the minimum house advantage of the range in parent claim 42 as being about minus 3% while newly added claim 131 defines the entire range as being about minus 3% to about 20%. Support for these parameters is found at page 18, line 9. Dependent claim 132 defines the minimum house advantage of the

range in parent claim 42 as being zero. Support for this is found at various portions of the specification, such as on pages 12, 15 and 16.

Note is also made to various claims which provide a payoff in the knowledge-based game even if a wrong answer is given. Such feature in its combination of features also merits patentability.

A. WALKER

It is respectfully submitted that parent claims 1, 19, 25 and 42 and their dependent claims are patentable over Walker. Walker relates to an electronic gaming device which offers a game of knowledge for enhanced payoffs. As disclosed at various portions of the Walker specification such as column 2, lines 43-60 "a player is permitted to play a game of knowledge, such as a trivia game, while playing a slot machine or other electronic gaming device. The player may be allowed to answer trivia questions while playing the slot machine (a) on a complimentary basis, primarily for entertainment purposes, as an incentive for continued play or (b) to increase prizes for slot play when trivia questions are answered correctly..." "...the player can use successful trivia game results to access higher reward levels with the slot machine."

The Walker disclosure is clearly unlike the inventions claimed herein by the applicant. Walker suggests a game which is intended to be self-funded. If a player answers wrong the player is penalized. Thus, Walker is actually pitting the players who answer correctly with the players who provide wrong answers. Such method would hurt the incentive to play by a player who considers himself

non-knowledgeable. Moreover, Walker does not address the conditions where the player might be someone who knows all answers. Instead, Walker resorts to such safety measures as storing "a sufficient supply of questions to ensure that the same player is not presented with the same question twice. In addition, players in close physical proximity to one another in a casino should also not be presented with the same questions." (Col. 8, lines 32-37)

Thus, unlike the claimed invention Walker does not disclose or suggest playing the game of knowledge when a bonus condition occurs in the game of chance. Walker does not suggest providing separate payoffs for the game of chance and for the knowledge based game. Instead the knowledge-based game affects the amount of the award from the game of chance. Further, Walker does not suggest providing a payoff from the game of chance which would be made regardless of and separate from the results of the knowledge-based game.

B. GB `642

It is further submitted that the claims are patentable over GB `642. GB `642 relates to a game machine of the fruit-machine type which has a reels display. The machine also includes a video display screen.

Pages 11-14 describe the operation of play. The player inserts coins and plays the fruit machine game. If there is no award and no features are offered, the player converts another credit and begins playing the fruit machine game again. During play of the fruit machines game, some symbols have numbers to create the trail

feature. If the player hits a winning combination, the player can either collect the award or if the trail is at a predetermined minimum, the player can have a feature routine initiated. The player would first gamble the amount won by a card guessing game. If the player is correct, the player can then either collect the award or gamble again or play a feature which, if won, would provide an award.

The attention of Examiner Pierce is particularly directed to page 12, lines 5 to page 13, line 1 of GB `642 which states "For any winning combination of symbols [of the fruit machine game], the player may simply collect the amount won using the collect button. If, however, the trail value reaches a predetermined minimum...the machine determines this and initiates a features routine displayed on the display screen 15. In this embodiment, the screened feature enables the player to "gamble" the amount won. An increased award is identified on the screen...if the player guessed correctly the gambled amount is achieved. It can be collected if wished. However, at this stage the player may also gamble further...If the player prefers to play a feature rather than gamble further, he can press the right-hand extra button causing the machine to send to the screen a selected one of a number of stored video games."

As pointed out not only in the description beginning on page 11, but also in the Abstract of GB `642, a precise sequence of events is required to reach a trivia question:

First, the player must continue to play
the fruit machine to hit certain "number"

symbols in order to reach a predetermined minimum on the trail. The trail qualification feature is critical to the '642 operation. It certainly requires the player to play a number of games in order to move up the trail which is not a requirement of applicant's invention. [An alternative to this first event, is suggested on page 3, line 20 that rather than using the "trail" system "opportunities to play the skill game may be presented in a random or quasi-random manner over the playing of a number of games..."]

Second, the player must continue to play to then obtain a winning combination with a payoff. Again, this is not a requirement in applicant's approach to play the knowledge game.

Third, the player receives a first choice element. If the player declines, the player receives the payoff. If the player decides to gamble, the payoff is fully at risk in the video game play. If successful, the player receives an increased award. None of this is found in applicant's design.

Fourth, the player receives a second choice element. If the player declines, the

player receives the increased award. If the player decides to gamble, the increased award is fully at risk in an interactive game of chance or skill which may/may not be a trivia question. The only similarity to applicant's game is the interactive game being a trivia question.

GB `642 does not disclose or suggest having a payoff from the first game of chance which is paid off independently of what occurs in a subsequent game. In that regard, when the player switches from the fruit machine game the player can either collect the award (which would mean there would be no second payoff) or if entitled by reaching a predetermined minimum on the trail system the player can then gamble the amount won which means that the player is risking losing the payoff from the first fruit machine game playing. This differs from the present invention where the first payoff is always made. [Such payoff might be zero if a bonus condition is reached before reaching a winning combination.] In GB `642 before the player can progress from the initial game of chance to a skill or knowledge based game the player must first be successful in a further game of chance, i.e., the gamble feature. This differs from the present invention in that with the present invention the player would proceed from an underlying game of chance to the knowledge based game without any intervening risks from a gamble feature or any other intervening game. In addition, with the invention the player does not risk the initial payoff when

proceeding to the knowledge based game by being forced to first play a gamble feature.

Although various generalities are made in the GB `642 patent with regard to features of the game machine, these generalities should be viewed within the context of the mode of operation specifically referred to above. Thus, while for example page 3, lines 20-23 refers to the opportunity to play a skill game in a random or quasi-random manner, the playing of that game within the context of the mode of operation specifically described would include the intervening gamble feature. Moreover, GB `642 in addition to the other references relied upon makes no suggestion of the house advantage parameters which are recited in parent claim 42 and its dependent claims.

To extract from the generalities that the GB `642 teachings could be construed as suggesting that the intervening gambling step could be omitted would require a teaching from applicant's own present application which would be a resort to hindsight. Thus, but for applicant's own teachings, it would be unreasonable to construe the "generalities" of GB `642 in any way that deviates from the specifically disclosed mode of operation. Consequently, GB `642 can teach only that which is discloses or clearly suggests, and not variations that could only be suspected or imagined, particularly when applicant's own disclosure is needed to provide the basis for such deviation.

C. KELLER AND GB `974

It is further submitted that the present invention is not

disclosed in or suggested by Keller or GB '974. Keller relates to an entertainment form of a casino game that enables a player to use winning tokens to then play a skill game. There is, however, only a single award. Specifically, Keller indicates that "The entertainment includes both a casino game and a skill game, and awards cash prizes only in connection with the skill game. Winners of the casino game are awarded only a token, which has no redeemable monetary value. The token merely allows the winner to enter the skill game and, if he or she can demonstrate the necessary skill, entitles the winner to a prize corresponding to indicium on the token." (Col. 1, lines 49-55) Thus, "If the individual succeeds in the skill game, he or she is awarded a prize based on an indicium that appears on his or her token." which is given in the casino game. (Col. 3, lines 17-20) It is submitted that it would be unreasonable to interpret Keller as suggesting that the token is a payoff from the underlying casino game. Such token has no monetary value. Moreover, there is no disclosure in Keller that the player would be entitled to keep the token. More likely, the token would be given back when the skill game is played. The Keller method is more similar to a carnival game than it is to a casino game. A fee is charged in Keller to play the game. No consideration is given for providing a house advantage as in a true casino game. Instead, the person running the game "may, but need not, require individuals to compensate him or her for the services being provided." (Col. 2, lines 1-3) Even, however, if the token were considered a payoff award from the skill game is not

separate and distinct from the token. Instead it is clearly dependent on what is the indicium on the token. Thus, there is, in fact, only a single award of value. The purpose of the first game is to determine the award from successful play of the second game.

GB '974 is similar to Keller in that the first game functions to determine the level of prize to be awarded while that award is made upon successful completion of the second game. See, for example, page 3, lines 8-15. There are therefore no two separate awards which are independent of each other as in the present invention.

Thompson was relied upon solely as a secondary reference in combination with Keller and does not overcome the deficiencies of Keller.

If Examiner Pierce has any suggestions for placing this application in its best condition for allowance he is respectfully requested to telephone the undersigned attorney at (302) 658-9141 or to telephone applicant's attorney Robert Dorr at (303) 333-3010.

In view of the above remarks and amendments this application should be passed to issue.

Respectfully Submitted,

By:



Harold Pezzner, Esquire

Reg. No. 22,112

Connolly Bove Lodge & Hutz, LLP

1220 Market Street

Wilmington, DE 19801

(302) 658-9141

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MARKED COPY OF AMENDED CLAIMS

1. (thrice amended) A method for playing a casino game comprising [the steps of]:

receiving a wager for the casino game,

playing an underlying game of chance in the casino game,

awarding payoffs when play of the underlying game of chance results in a winning combination.

playing a knowledge-based bonus game in the casino game using answers from a player when a bonus condition occurs in the underlying game, playing the knowledge-based game after playing the game of chance without any intervening game which would affect the payoff of the game of chance, the play of the knowledge-based game having a bonus payoff separate from the payoffs awarded in the play of the underlying game of chance so that the entitled payoffs are made for the underlying game regardless of the outcome of the knowledge-based game, the combined play of both the knowledge-based bonus game with the underlying game of chance over time having a house advantage for the casino game within a predetermined range, the predetermined range having set limits based on the correctness of the answers and the wager.

4. (amended) The method of claim [3] 1 further comprising the step of restarting the play of the underlying game of chance when the play of the knowledge-based bonus game is over.

5. (twice amended) The method of claim [3] 1 wherein [stopping the underlying game of chance is based upon a condition occurring in the play of the underlying game of chance,] the bonus condition [being] is one of the following: the appearance of a bonus symbol in the step of playing of the underlying game of chance or a random number of wagers received in the step of

receiving.

6. (twice amended) The method of claim [3] 1 wherein [stopping the underlying game of chance is based upon a] the bonus condition [occurring] occurs unrelated to the play of the underlying game of chance, the bonus condition being one of the following: the timing out of a random timer in the play of the underlying game of chance or an appearance of a number in a random roll of dice after the play of the underlying game of chance.

7. (twice amended) The method of claim [3] 1 wherein the bonus condition [stopping of the underlying game of chance] occurs at a known frequency.

8. (twice amended) The method of claim [3] 1 wherein the bonus condition [stopping of the underlying game of chance] is randomly chosen at a known frequency.

19. (amended) A method for playing a combined knowledge-based bonus game with an underlying casino game of chance, the method comprising [the steps of]:

receiving a wager,

playing the underlying casino game of chance,

stopping play of the underlying casino game of chance,

paying the player when a winning combination occurs in the underlying casino game of chance,

playing the knowledge-based bonus game when the underlying casino game of chance is stopped and a bonus condition occurs in the underlying game, the steps of playing the knowledge-based game at least [having the steps of] comprising:

(a) providing at least one query to the player in the knowledge-based game,

(b) receiving at least one answer from the player in response to the provided at least one

query,

(c) paying the player based upon the at least one answer by the player,

(d) paying the player the entitled payoff of the underlying game regardless of the outcome of the knowledge-based game,

(e) playing the knowledge-based game after playing the game of chance without any intervening game which would affect the payoff of the game of chance,

providing a house advantage within a predetermined range for the combined knowledge-based bonus game and underlying casino game, the predetermined range having a set limit based at least upon all answers to all queries in the knowledge-based game are always correct and the wager.

24. (amended) The method of claim 19 wherein the step of playing the player further comprises [the steps of]:

paying the player a first amount when the player correctly answers the at least one query,

paying the player a second amount when the player incorrectly answers the at least one query.

25. (twice amended) A method for playing a combined knowledge-based bonus game with an underlying casino game of chance, the method comprising [the steps of]:

playing the underlying casino game of chance,

awarding payoffs when play of the underlying game of chance results in a winning combination,

playing the knowledge-based bonus game when play of the underlying game of chance stops and a bonus condition occurs in the underlying game, the play of the knowledge-based bonus

game being separate from the underlying [game] casino game of chance so that the entitled payoffs are made for the underlying game regardless of the outcome of the knowledge-based game, playing the knowledge-based game after playing the game of chance without any intervening game which would affect the payoff of the game of chance.

the steps of playing the knowledge-based game at least [having the steps of] comprising:

- (a) providing at least one query to a player in the knowledge-based game,
- (b) receiving at least one answer from the player in response to the provided at least one query,

- (c) paying the player based upon the at least one answer received,

the separate play of the knowledge-based bonus game with the underlying casino game having a house advantage in a range from a first set limit based on all answers to all queries are correct to a second set limit based on all answers to all queries are guessed.

27. (amended) The method of claim 25 wherein the step of playing the knowledge-based bonus game is based upon [a condition] the bonus condition [occurring in] related to the play of the underlying casino game.

28. (amended) The method of claim 25 wherein the step of playing the knowledge-based bonus game is based upon [a] the bonus condition occurring unrelated to the play of the underlying casino game of chance game.

29. (twice amended) The method of claim 25 wherein the step of playing the knowledge-based bonus game is randomly chosen at a known frequency.

30. (amended) The method of claim 25 wherein the step of playing the knowledge-based bonus game is randomly chosen at a known frequency.

42. (twice amended) A method for a casino game comprising [the steps of]:

providing a first game of chance,

paying the player a payoff when a winning combination results in the game of chance,

providing a second knowledge-based game,

playing the first game of chance having a [negative player's expected return relative to a player's wager] positive house advantage,

stopping play of the first game of chance when a bonus condition occurs in the first game of chance,

playing the second knowledge-based game using answers from a player when the first game is stopped, [the second knowledge-based game always having a positive player's expected return,] paying the player the entitled payoff of the underlying game regardless of the outcome of the knowledge-based game[.].

playing the knowledge-based game after playing the game of chance without any intervening game which would affect the payoff of the game of chance,

providing a house advantage within a predetermined range for the combined second knowledge-based game and the first game of chance wherein the predetermined range has had a minimum house advantage based upon all answers to all queries in the second knowledge-based game being correct, and a substantial portion of the range being a positive house advantage.

43. (amended) The method of claim 42 further comprising the step of returning to the play of the first game of chance when the play of the second knowledge-based game is over.

44. (amended) The method of claim 42 wherein the first game of chance is a slot game.

45. (amended) The method of claim 42 wherein the step of stopping the first game of chance is based upon a condition occurring in the play of the first game of chance.

46. (amended) The method of claim 42 wherein the step of stopping the first game of chance is based upon a condition occurring unrelated to the play of the first [casino] game of chance.

49. (amended) The method of claim 42 wherein the [positive player's expectation is at least a second set] upper limit of the house advantage range is based upon all answers to all queries in the second knowledge-based game always being guessed at.

55. (amended) The method of claim 50 wherein the step of paying the wager for the second knowledge-based game further comprises [the steps of]:

paying a first amount when the correct answer is provided for the at least one query,

paying the second amount when the incorrect answer is provided for the at least on query.

57. (amended) The method of claim 42 wherein the step of playing the second knowledge-based game provides only one query.

58. (amended) The method of claim 42 wherein the step of playing the second knowledge-based game provides at least one query.

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